

REMARKS

Claims 1-28 are pending in the application. By the present amendment, claim 4, 16-18, and 28 are amended.

Applicants believe the amendments made herein add no new matter. Any amendments to the claims which have been made in this amendment, and which have not been specifically noted to overcome a rejection based on prior art, should be considered to have been made for a purpose unrelated to patentability, and no estoppel should be deemed to be attached thereto.

Reconsideration and reexamination of the application is respectfully requested in view of the pending claims and the following remarks.

Rejections Under 35 U.S.C. 112

Claim 28 stands rejected under 35 U.S.C. §112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The rejection is respectfully traversed.

Claim 28 as filed mistakenly called for a “vacuum cleaner”, and has been corrected by the present amendment to call for a “cyclone separator module”, which has proper antecedent basis. Applicants respectfully request withdrawal of the rejection.

Rejections Under 35 U.S.C. 102

Claims 1, 4-9, 15, and 18-23 stand rejected under 35 U.S.C. §102(e) as being anticipated by Hitzelberger (US7152275). The rejection is respectfully traversed.

The pending claims call for a vacuum cleaner (independent claim 1) or a cyclone separator module (independent claim 15) comprising, *inter alia*, a housing defining a cyclonic airflow chamber and having a cyclonic chamber inlet and an airstream outlet in fluid communication with the cyclonic airflow chamber, a dirt-collecting bin mounted to the housing adjacent the cyclonic airflow chamber and in communication therewith to receive dirt separated from the airstream in the cyclonic airflow chamber, a hollow standpipe extending through the dirt-collecting bin and extending through a wall in the dirt collecting bin, and a filter chamber

mounted to the dirt-collecting bin including an inlet opening in communication with the standpipe.

In order to anticipate the claims, each and every limitation in the claims must be found in Hitzelberger. Because Hitzelberger does not disclose each and every element of the claims, the anticipation rejection fails.

Hitzelberger discloses a vacuum cleaner having a cyclone separator 26 with an integral cyclonic chamber and dirt-collecting chamber. A filtering subassembly 36 is arranged in an upper portion of the cyclonic chamber, and is upstream of a discharge conduit 60 that extends vertically from the filtering subassembly 36 to a discharge port 58 in the bottom wall of the cyclone separator 26. While not shown in the drawings, a filter is said to be downstream of the cyclone separator 26. The filter is said to be in the compartment holding the fan and drive motor assembly 30.

Hitzelberger does not disclose a filter chamber mounted to the dirt-collecting bin, as required by the claims. The Examiner cites column 4, lines 57-64 as teaching this feature of the claims. However, the cited text is vague on where the filter is located, and the drawings do not show the filter. While Hitzelberger generically discloses a filter in the compartment holding the fan and drive motor assembly 30, the disclosure does not provide support for the teaching of a filter chamber mounted to the dirt-collecting chamber. On the contrary, the drawings and disclosure of Hitzelberger support the filter being separate from the dirt-collecting chamber, since the dirt-collecting chamber is shown in a position removed from the vacuum cleaner in Fig. 4 and does not show any type of attached filter chamber. Therefore, since Hitzelberger fails to disclose a filter chamber mounted to the dirt-collecting bin, Hitzelberger does not anticipate claims 1, 4-9, 15, and 18-23, and claim 1, 4-9, 15, and 18-23 are patentable.

Rejections Under 35 U.S.C. 103

Claims 2, 3, 16, and 17 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Hitzelberger in view of Oh (US20020178702). The rejection is respectfully traversed.

In order to establish a *prima facie* case of obviousness, several basic criteria must be met. Under *Graham v. John Deere*, 383 U.S. 1 (1966), it is necessary to: (1) determine the scope and content of the prior art; (2) ascertain the differences between the prior art and the claims at issue; (3) resolve the level of ordinary skill in the pertinent art; and (4) evaluate evidence of secondary consideration. Additionally, the obviousness evaluation will be informed by a showing of teaching, suggestion, or motivation that would lead a person of ordinary skill in the art to combine the prior art to meet the claimed subject matter, although a rigid application of this showing is not required. The obviousness analysis must be explicit, and it is necessary to identify a reason that would have prompted a person of ordinary skill in the relevant field to combine the prior art elements in the manner claimed. *KSR Int'l Co. v. Teleflex, Inc.*, 550 U.S. __; 127 S. Ct 1727; 82 U.S.P.Q.2d (BNA) 1385 (2007).

Applicants respectfully traverse the combination of Hitzelberger and Oh for several reasons. First, the Examiner has not met the burden of establishing a *prima facie* case of obviousness because the Examiner bases the combination on a mischaracterization of Hitzelberger. A mischaracterization of the prior art necessarily results in the Examiner failing to determine the scope and content of the prior art. The Examiner states that Hitzelberger teaches a filter chamber mounted to the dirt-collecting bin (Office Action, pg. 3). As discussed above, Applicants find that Hitzelberger inherently discloses the filter chamber being separate from the dirt-collecting chamber, since the dirt-collecting chamber is shown in a position removed from the vacuum cleaner in Fig. 4 and does not show any type of attached filter chamber.

Second, the Examiner has not met the burden of establishing a *prima facie* case of obviousness because the Examiner fails to ascertain the differences between the prior art and the claims, which results from a failure to properly determine the scope and content of Hitzelberger. Hitzelberger does not teach a filter chamber mounted to the dirt-collecting bin, as called for in the claims. However, the Examiner's basis for forming the combination asserted against the claims is that Hitzelberger taught all the limitations of the rejected claims, save for the removable mounting limitation (Office Action, pg. 5). Without the teaching of a filter chamber

mounted to the dirt-collecting bin in Hitzelberger, there is no basis for making the combination with Oh to reach the claims.

Even if the combination of Hitzelberger and Oh could be made, however untenably, the alleged combination does not reach the claimed invention. Hitzelberger does not teach a filter chamber mounted to the dirt-collecting bin, as called for in the claims. Oh discloses a cyclone separator 10 having a detachable dirt-collecting bin 30, but does not show any a filter chamber, and therefore does not remedy the deficiency in Hitzelberger. Since neither reference teaches a filter chamber mounted to a dirt-collecting bin, it stands to reason that any combination of the references will also fail to have this teaching. As this element is completely missing from the combination, claims 1 and 15 are not obvious in view of the combination. Claims 2, 3, 16, and 17 are also patentable over the combination based on their direct or indirect dependency on claim 1 or 15.

Claims 10-14 and 24-28 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Hitzelberger. The rejection is respectfully traversed.

Claims 10-14 and 24-28 are dependent on either claim 1 or claim 15. As discussed above, Hitzelberger does not anticipate claims 1 and 15; Hitzelberger further does not render claims 1 and 15 obvious. There is no teaching in Hitzelberger of a filter chamber mounted to the dirt-collecting bin, as required by the claims, nor would it be obvious to modify Hitzelberger to have this teaching. In order to modify Hitzelberger to produce the claimed invention, there must be some teaching, suggestion or motivation to do so (see *In re Kahn*, 441 F.3d 977). A reference may be said to teach away when a person of ordinary skill, upon reading the reference, would be discouraged from following the path set out in the reference, or would be led in a direction divergent from the path that was taken by the applicant. *In re Gurley*, 27 F.3d 551 (Fed. Cir. 1994). A person skilled in the art would be led away from mounting a filter chamber to a dirt-collecting bin by the disclosure of Hitzelberger, which inherently teaches the filter chamber being separate from the dirt-collecting chamber, since the dirt-collecting chamber is shown in a position removed from the vacuum cleaner in Fig. 4 and does not show any type of attached filter chamber. Therefore, since Hitzelberger teaches away from the modification required to

Serial No. 12/339,994
Filed: December 19, 2008
Page 11 of 11

Examiner: Robert J. Scruggs
Group Art Unit: 3723

reach the claims, Hitzelberger does not render claims 1 and 15, and any claims thereon, including claims 10-14 and 24-28 obvious. Claims 10-14 and 24-28 are therefore patentable over Hitzelberger.

Conclusion

For the reasons discussed above, all claims remaining in the application are believed to be allowable over the prior art. Early notification of allowability is respectfully requested. If there are any remaining issues which the Examiner believes may be resolved in an interview, the Examiner is respectfully invited to contact the undersigned.

Respectfully submitted,

Joseph A. Fester

Date: December 3, 2009

By: _____/Erin E Dams/

Erin E. Dams, Reg. No. 61,481
John E. McGarry, Reg. No. 22,360
McGARRY BAIR PC
32 Market Ave. SW, Suite 500
Grand Rapids, Michigan 49503
(616) 742-3500